

LAW OFFICES OF MARK H. PLAGER, P.C.

Sea Cliff Office Park
2134 Main Street, Suite 130
Huntington Beach, California 92648
Telephone: (714) 374-9160
Alt. Telephone: (714) 827-1279
Fax: (714) 374-9170

RECEIVED
CENTRAL FAX CENTER
OCT 06 2005

FAX COVER SHEET**FAX NUMBER TRANSMITTED TO: (571)273-8300**

To: A. Phi Dieu Tran
Of: USPTO, Group Art Unit 3637
From: Mark Plager
Client/Matter: 10072-002
Date: October 6, 2005 (12:43pm)

DOCUMENTS	NUMBER OF PAGES*
Response to 9/15/05 Office Action	3

CONFIDENTIALITY NOTE:

The information contained in this facsimile message is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution or copy of this telecopy is strictly prohibited. If you have received this telecopy in error, please immediately notify us by telephone and return the original message to us at the address above via the United States Postal Service. Thank you.

COMMENTS:

* NOT COUNTING COVER SHEET. IF YOU DO NOT RECEIVE ALL PAGES, PLEASE TELEPHONE US IMMEDIATELY AT (714) 374-9160

RECEIVED
CENTRAL FAX CENTER**OCT 06 2005****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

1
2
3
4
5
6
7
8
9
10 Inventor: Thomas R. Herren) G.U.A.
11 Serial No.: 10/600,806) 3637
12 Title: Multipurpose Construction)
13 Assembly and Method)
14 Filed: 06/19/2003)
15 Examiner: A. Phi Dieu Tran)

RESPONSE TO DETAILED ACTION
Election / Restriction

16
17
18
19 Ass't Commissioner of Patents
20 P.O. Box 1450
Alexandria, Virginia 22313-1450

21 Sir:

22 In response to the September 15, 2005 Restriction of the above-referenced patent
23 application. The applicant finds the Office Action to be incomplete, non-informing, and
24 improper pursuant to § 707.07(d) of the Manual of Patent Examination Procedure. Section
25 707.07(d) states "where a claim is refused for any reason relation to the merits thereof it should
26 be 'rejected' and the ground of rejection fully and clearly stated . . ." M.P.E.P. §707.07(d). The
27 Examiner's restriction fails to "fully and clearly" identify which, if any, claims constitute "two or
28 more independent and distinct inventions."

Section 121 of the Patent Act provides that "[i]f two or more independent and distinct

1 inventions are claimed in one application, the Commissioner may require the application to be
2 restricted to one of the inventions." 35 U.S.C. 121 (emphasis added). The Examiner's
3 restriction is not predicated upon the claims of the pending application, but rather the figures.
4 Figures of a patent application do not define the scope of the applicant's claimed invention. *See*
5 *Kaplan v. Robertson*, 50 F.2d 617, 620 (D.Md. 1931)(Description of invention as contained in
6 claims, interpreted in light of specifications, is to be neither restricted nor extended by drawings).
7 *See, also, Harvey Hubbell, Inc. v. General Electric Co.*, 267 F. 564, 570 (2d Cir. 1920). Rather,
8 the scope of the applicant's invention is defined by the claims. *See* 35 U.S.C. 112 ¶ 2 ("The
9 specification shall conclude with one or more claims particularly pointing out and distinctly
10 claiming the subject matter which the applicant regards as his invention."); *See, also, Ziegler v.*
11 *Phillips Petroleum Co.*, 483 F.2d 858, 869, 177 U.S.P.Q. 481 (5th Cir. 1973), *certiorari denied*,
12 94 S.Ct. 597, 414 U.S. 1079, 38 L.Ed.2d 485, 180 U.S.P.Q. 1 (Claims delineate scope of
13 protection afforded by a patent, not specific embodiments shown in patent drawings).
14 Consequently, the Examiner's restriction is improper because it fails to identify which, if any,
15 claims support the existence of "two or more independent and distinct inventions" within the
16 subject application.

17 Applicant cannot respond to the September 15, 2005 Office Action because it fails to
18 provide "full and clear" identification of which, if any, claims constitute "two or more
19 independent and distinct inventions." Accordingly, Applicant requests a restriction requirement,
20 if indeed one is required, which adequately provides a basis and rationale, (i.e., the identification
21 of claims which constitute two or more independent and distinct inventions), which can be
22 reasonably addressed by means of a response. With respect to such a response, Applicant
23 requests a reasonable time period to prepare such a response.

24 Respectfully Submitted,

25
26 October 5, 2005



27 Mark H. Plager, Reg. No. 35,648
28 Attorney for Applicant

1 PLEASE RESPOND TO:

2 Mark H. Plager
3 Plager Law Offices, P.C.
4 2134 Main Street, Suite 130
5 Huntington Beach, California 92648
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28